IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s)	: Boon-Lock YEO	Group Art Unit: 2623
Appln. No.	: 09/670,865	Examiner: Usha Raman
Filed	: September 27, 2000	Confirmation No.: 7873
For	: SUMMARY FRAMES IN VIDEO	

REQUEST FOR PRE-APPEAL BRIEF REVIEW

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop AF
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

This request is being filed concurrently with a Notice of Appeal. Reconsideration of the rejections of claims 21 – 32 and 34 – 38 is respectfully requested in view of the following remarks.

A prima facie case of unpatentability has not been set forth and the Rejections Under 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a) Are Improper

Examiner's Assertion:

The Examiner asserts that, in the Office Action dated December 15, 2006, claims 21 – 28 and 36[1] – 38 were properly finally rejected under 35 U.S.C. § 102(e) and claim 29 was properly finally rejected under 35 U.S.C. § 103(a) over U.S. Patent 5,852,474 to Nakagaki et al. ("Nakagaki"). This is notwithstanding the fact that independent claims 21, 25 and 36 were not treated as claimed. In the Examiner's post hoc comments in the Advisory Action dated April 2, 2007, the Examiner argued that the claim term "when" is interchangeable with "after".

Applicants' Reply:

Applicants do not agree with the Examiner. Specifically, the Examiner did not properly interpret, and hence did not address, the features: ". . . at a same time when said programming

[1] Applicants note that claim 36 was not included in the statement of the rejection of the Office Action dated December 15, 2006. However, an explanation as to the rejection of claim 36 is provided in the Office Action. Accordingly, Applicants treated claim 36 as rejected under 35 U.S.C. § 102(e) by Nakagaki.

channel is changed" (claims 21 and 36) and ". . . when said programming channel is changed . . ." (claim 25).

In rejecting claims 21 and 25 (and 36, as the Examiner applied the same rejection as claim 21) in the final Office Action dated December 15, 2006, the Examiner substituted the claimed "when" with the term "after". Specifically, the Examiner stated:

> At least one summary frame (subordinate screen) also displayed on the display screen overlaid onto the video program in progress at the same time (see fig. 12B) after the programming channel is changed (see col. 4, lines 37 – 42, on receiving signals of a broadcast programs necessitates the step of tuning to that channel), the at least one summary frame comprising past frame from the video program in progress. (emphasis added)

In responding to Applicants' arguments, in the Advisory Action of April 2, 2007, the Examiner asserted that the above-noted features of claims 21 and 25 were addressed. Specifically, the Examiner provided examples and further noted that "'when' can also mean 'after'." However, Applicants argued and again submit that the term "after" is not that same as "when" and, accordingly, the Examiner did not properly interpret and address the feature "*when said programming channel is changed*."

Applicants note the guidance provided by MPEP § 2111, that the interpretation of the claims must be consistent with the "interpretation that those skilled in the art would reach." Additionally, MPEP § 2111.01 states that ". . . the intrinsic record must be consulted to identify which of the different possible definitions is most consistent with applicant's use of the terms," and "[w]here there are several common meanings for a claim term, the patent disclosure serves to point away from the improper meanings and toward the proper meanings."

Applicants submit that the term "when" in claims 21, 25 and 36 is defined in the specification differently than the interpretation given by the Examiner. For example, this language is explained in the specification at least at page 3, lines 13 – 17, which states (emphasis added):

> Hence, when a channel surfer arrives at a new channel, rather than only having what is currently playing to catch the eye, summary frames are also available to catch the surfer's attention and aid in understanding the programming.

Thus, Applicants submit that the term "when" is clearly defined in the specification to mean at the time, or concurrent to, connoting at least two things occurring simultaneously. In contrast, the Examiner is using the term "when" to mean after, connoting one thing occurring subsequent to another thing. For this reason the Examiner's interpretation of "when" is inconsistent with the specification, and thus, is not within the broadest reasonable interpretation consistent with the

specification. Accordingly, Applicants submit that the Examiner did not properly reject claims 21, 25 and 36.

Using the proper definition, or meaning, of "when", Applicants submit that Nakagaki would not anticipate the claimed invention. More specifically, Nakagaki discloses a delay circuit that will record a currently-watched television signal for delayed viewing. When a user changes a channel, the delay circuit will only then begin to record that channel in the delay circuit. Therefore, at the point a channel is changed from an "old" channel to a "new" channel, the delay circuit will not have any of the "new" channel recorded therein. Thus, it would be impossible for Nakagaki to display at least one summary frame comprising a past frame from the video program in progress at the point a channel is changed from an "old" channel to a "new" channel, as the delay circuit will not have any of the "new" channel recorded therein. In contrast, in the claimed invention, at the point the channel is changed to a "new" channel, at least one summary frame comprising a past frame from the video program in progress on the "new" channel is immediately displayed.

For these reasons, Applicants respectfully submit that these claim features were never properly addressed, and consequently, a complete action was not provided.

Examiner's Assertion:

The Examiner asserts that claim 36 was properly finally rejected under 35 U.S.C. § 102(e) over Nakagaki as applied to claims 21 – 24 in the Office Action of December 15, 2006.

Applicants' Reply:

Applicants do not agree with the Examiner. Specifically, Applicants submit that each of the features of claim 36 was not addressed in the rejection. Claim 36 recites, *inter alia*:

> . . . at least one preview frame comprising a future frame from said video program in progress displayed at a same time as said at least one summary frame and said video program in progress . . . (emphasis added)

Applicants submit that the Examiner improperly treated claim 36 by stating, "[w]ith regards to claim 36, the limitations of the claims have been discussed with regards to claims 21 – 24." Applicants note the guidance provided by MPEP § 707(d), which states:

> A plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group.

Applicants respectfully submit that the above-noted feature of claim 36 is not recited in any of claims 21 – 24. Thus, Applicants submit that the rejection of claims 21 – 24 is not

applicable to claim 36, and therefore grouping the rejection of claim 36 with the rejection of claims 21 – 24 was improper. In any event, as discussed above, Nakagaki does not disclose the common features of the claimed invention.

For these reasons, Applicants respectfully submit that these claim features were never properly addressed, and consequently, a complete action was not provided.

Examiner's Assertion:

The Examiner asserts that claims 30, 32, 34 and 35 were properly finally rejected under 35 U.S.C. § 103(a) over U.S. Patent 6,732,369 to Schein et al. ("Schein"), and that claim 31 was properly finally rejected under 35 U.S.C. § 103(a) over Schein in view of U.S. Patent 5,815,145 to Matthews, III ("Matthews"). In the Office Action, the Examiner took Official Notice that that it is well known to broadcast previews after returning from commercial breaks.

Applicants' Reply:

Applicants do not agree with the Examiner. The Examiner acknowledged that Schein does not disclose "displaying said summary frames on a screen at a same time with said video program when a viewer changes to said video program." However, the Examiner took Official Notice "that it is well known to broadcast previews after returning from commercial breaks" and further reasons that "[i]n such a case, when the viewer changes to the channel at the end of the commercial break, the user is presented with a preview upon changing to that channel."

Applicants submit that the taking of Official Notice is improper in this instance, as the facts the Examiner asserts to be well-known are not capable of instant and unquestionable demonstration so as to defy dispute. Moreover, Applicants submit that it is not well-known to broadcast a preview of a currently-watched program after returning to the currently-watched program from a commercial break, as suggested by the Examiner.

The Examiner supported the Official Notice by citing U.S. Patent 6,412,111 to Cato ("Cato"). While Cato may disclose that it is well-known to broadcast previews upon returning from a commercial break, Applicants submit that Cato does not disclose, nor is it well known in the art to, broadcast a summary frame depicting scenes from a video program upon returning to that video program from a commercial break. So, even under the Examiner's hypothetical situation of changing to a channel airing a current program at the moment a preview is airing after a commercial break, Applicants submit that the preview would not be for the current program.

Additionally, assuming *arguendo* that it is well known to broadcast previews upon returning from a commercial break (which Applicants do not concede), Applicants submit that

Schein in view of the Examiner's Official Notice does not teach or suggest displaying the video program and the summary frames on a screen at a same time with the video program when a viewer changes to the video program. The Examiner presented a hypothetical situation in which a user, utilizing the system of Schein, is watching a program and at the same time is using the electronic program guide (EPG), with the EPG tuned to the same channel that is currently being watched. Thus, in this case, the screen would display the current program and a sub-screen also showing the current program, as is shown in Fig. 17B. Under these circumstances, the Examiner asserts that it is possible to change to a channel at a particular time when the program is showing a "preview". However, Applicants submit that both the main image and the sub-screen are displaying the "preview", and that there is no suggestion or motivation otherwise shown in the reference to provide the claimed invention. Thus, Applicants submit that even in this hypothetical situation, Schein in view of Official Notice does not teach or suggest displaying the video program and the summary frames on a screen at a same time with the video program when a viewer changes to the video program.

Additionally, as claim 31 depends from claim 30, Applicants submit that the rejection of claim 31 is likewise improper.

For these reasons, Applicants respectfully submit that these claim features were never properly addressed, and consequently, a complete action was not provided.

Conclusion

Accordingly, Applicants respectfully request that the Examiner's decision to finally reject claims 21 – 32 and 34 – 38 be withdrawn and the application be returned to the Examiner for allowance.

Respectfully submitted,
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